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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,462	02/28/2002	Tomohiro Koyata	7217/66559	1812
530 7590 01/10/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER BAYAT, BRADLEY B	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/085,462	Applicant(s) KOYATA ET AL.	
	Examiner Bradley B. Bayat	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-11,13,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-11,13,16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

This communication is in response to amendment filed on October 15, 2007. Claims 1 and 11 have been amended. Thus, claims 1, 3, 6-11, 13, 16 and 17 remain pending.

Response to Arguments

Applicant's arguments with respect to above-noted claims have been fully considered but they are not persuasive.

Please note that the amendments fail to further limit the claims because optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.").

"As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted." *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)(where the Federal Circuit affirmed the Board's claim construction of "further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased" since "this additional content did not narrow the scope of the claim because these limitations are stated in the permissive form 'may.'").

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the

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teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicant contends "it would not have been obvious to condition Shimoyoshi's moving, restoring, and converting operations on Ginter's validation of the electronics rights information (response p. 10)." As provided in the background and object of the invention, Shimoyoshi discloses that employing such conversion mechanisms improves compression efficiency especially since it allows for providing a large number of music that can be enjoyed by a consumer outdoors or mobile (2:5-21). Dissemination of such music and clearly restoring of a previously purchased music would require authorization and a DRM enforcement mechanism, as provided by Ginter.

Allowable Subject Matter

Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 3, 6-11, 13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (hereinafter Ginter), US 2004/0133793 A1 in view of Shimoyoshi et al. (hereinafter Shimoyoshi), US 5,548,574.

As per the following claims, Ginter discloses:

1. Ginter discloses a digital signal processing apparatus comprising:

- transmitting means for transmitting inquiry information to an information center over a communication line, said inquiry information being generated in association with encoded digital data which have been recorded on a storage medium [0008; 0221-222];

- receiving means for receiving a result of an inquiry conducted by said information center based on said inquiry information [0226-0240];

- discriminating means for judging, based on said result of said inquiry, whether said encoded digital data recorded on said storage medium are legally purchased data [1118, 1126, 1540, 1858, 1971-1975]; and

- controlling means which, when said discriminating means judges said encoded digital data to be legally purchased data, then executes a process to offer an additional service to said customer, wherein said additional service offered to said customer [0057-0093, 0192, 0208, 0215-0222].

Ginter does not explicitly disclose that the controlling means also includes moving said encoded data from said storage medium to another storage medium; restoring said encoded digital data onto said storage medium if the encoded digital data has been partially destroyed; and converting and replacing said encoded digital data recorded on said storage medium into encoded digital data of a different bit rate.

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Shimoyoshi, however, teaches controlling means that includes moving said encoded data from said storage medium to another storage medium; restoring said encoded digital data onto said storage medium; and converting and replacing said encoded digital data recorded on said storage medium into encoded digital data of a different bit rate (see summary columns 3-4; col 8, 36-col 10, 24; col. 21-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ginter to include the mechanism of Shimoyoshi to provide a recording/reproducing apparatus which is capable of accommodating plural usages having different demand levels while reducing the economic load without jeopardizing and lowering the dependability and quality to the customer, respectively.

2. Canceled.

3. A digital signal processing apparatus according to claim 1, wherein said additional service is offered to said customer by said controlling means converting said encoded digital data recorded on said storage medium with an algorithm of a predetermined version, into digital data having undergone encoding with an algorithm of a more advanced version, before replacing the unconverted digital data with the converted digital data on said storage medium [0965, 1478, 1511, 2017, 2280].

4. Canceled.

5. Canceled.

6. Ginter further discloses a digital signal processing apparatus according to claim 1, wherein said additional service offered to said customer comprises furnishing said customer, free of charge, with a product related to a producing party who produced said digital data purchased legally by said customer from said information center [0107-0141].

7. Ginter further discloses a digital signal processing apparatus according to claim 1, further comprising inputting means for inputting identification information for identifying said encoded digital data which are subject to said inquiry; wherein said identification information input through said inputting means is transmitted to said information center over said communication line [0193-0229].

8. Ginter further discloses a digital signal processing apparatus according to claim 7, wherein said information center comprises: receiving means for receiving said inquiry information and said identification information for identifying said encoded digital data which are subject to said inquiry transmitted from said encoded digital signal processing apparatus; retrieving means for retrieving said digital data subject to said inquiry from said information center in association with said identification information for identifying said encoded digital data; reference inquiry information generating means for generating reference inquiry information in association with said encoded digital data retrieved by said retrieving means; comparing means for comparing said reference inquiry information generated by said reference inquiry information generating

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means with said inquiry information received by said receiving means; inquiry result generating means for generating an inquiry result based on a result of the comparison by said comparing means; and transmitting means for transmitting said inquiry result generated by said inquiry result generating means [0509, 0722].

9. Ginter further discloses a digital signal processing apparatus according to claim 8, wherein said reference inquiry information generating means subjects part of said encoded digital data retrieved by said retrieving means to an encoding process executed by a software encoder, the coded data part being compared with said inquiry information by said comparing means [1350-1814].

10. Ginter further discloses a digital signal processing apparatus according to claim 1, further comprising charging means for processing charges; wherein, if said discriminating means judges that said encoded digital data recorded on said storage medium are legally purchased data, then said charging means either charges nothing or a reduced amount to said customer for said additional service offered to said customer [0222-0272].

Claims 11, 13, 16 and 17 are directed to a method of the above-recited apparatus and are similarly rejected.

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the

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teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

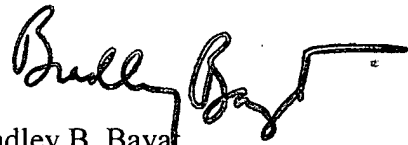
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8 a.m.-6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Bradley B. Bayat", with a stylized flourish at the end.

Bradley B. Bayat
Primary Examiner
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